

### **REMARKS**

Applicant respectfully requests reconsideration of the rejection of the claims. This Amendment amends claim 1, cancels claim 21 without prejudice, and adds new claims 24-29. The essence of the subject matter of claim 21 has been incorporated into claim 1. Additionally, claim 1 has been amended to recite further distinctions not found in the newly cited reference. A total of 13 claims remain in the case, i.e., 3 independent claims and 10 dependent claims.

New claim 24 is an independent claim and is addressed to a clip in the environment of spacing a first substrate away from a second substrate. Support for the recitations appearing in new claim 24 appears in Figure 3 and in paragraph [0027] of the specification. New claim 25 depends on claim 24 and recites that the prong members have pointed ends and a barb along their length. New claim 26 depends on claim 24 and recites that the radius of the step portion ranges between 0.25 and 0.50 inch. New claim 27 depends on claim 24 and recites that the clip is a metal material.

New claim 28 is an independent claim and is similar to claim 1 as amended but recites "consisting of" instead of "comprising" in the pre-amble. New claim 29 depends on claim 28 and includes the subject matter of claims 4-6.

### **The Claimed Invention**

The claimed invention, particularly claim 1, as amended, relates to a clip consisting of a body with two sides, a flat portion between the two sides, a single step portion on the flat portion, the flat portion having portions located on opposite sides of the single step portion, a first prong member projecting outward from the first side of the body and a second prong member projecting outward from the second side of the body. The entire clip member consisting of its several portions and prong members is formed from a single member and thereafter the body is bent in one direction to form the single step portion 14, and the prong members 16, 17 are bent in an opposite direction as disclosed in the specification and as illustrated in Figures 2A-2D. The single step portion 14 has an open faced recess projecting outwardly in the first direction (shown in Figure 2B). The material thickness for the flat portion, the step portion 14, the first prong member 16 and the second prong member 17 is uniform as shown in Figure 2B. The planar width of the first prong member 16 substantially

along its length and the planar width of the second prong member 17 substantially along its length are substantially less than the planar width of the flat portion and the single step portion 14. This is illustrated in Figure 2A. The first prong member and the second prong member consist of one flat plane as illustrated in Figures 2A and 2B. The prong members 16, 17 are straight, unbent single length members, each having a pointed end and barbs along their length. These structural features of the prong members 16, 17 of the clip are important distinctions which enable the clip 10 to easily pierce into a substrate and then be secured therein.

As claimed in claim 22, the portions of the flat portion located between the two sides of the body and opposite to the step portion 14 (shown better in Figure 2B) have a smooth and continuous undersurface extending between the single step portion 14 and the prong members 16, 17. As recited in claim 23, this clip is structured for use with sound absorbing media used with roof decks.

New independent claim 24 recites essentially the same distinctions found in claim 1, and include further distinctions, for example, that the clip is used for spacing a first substrate away from a second substrate; that the prong members 16, 17 are adapted to be received in the first substrate; that the portions of the flat portion on opposite sides of the single step portion 14 are adapted to abut the first substrate; that the single step portion 14 is adapted to abut the second substrate for the spacing of the two substrates; and that the single step portion 14 is adapted to maintain its form for the spacing of the two substrates. Support for these additional distinctions is found in the figures and/or in the specification.

Since the clip is used in the environment of spacing apart two substrates, it is important that the single step portion 14 is shaped such that it can initially establish and then maintain an appropriate spacing between the two substrates. Thus, the importance for the radius of the single step portion 14 being recited in new claim 26. It is also important that the clip be substantially rigid so that it can first be pushed into and penetrates the first substrate and then remain in the first substrate so that it establishes and maintains the appropriate spacing between the two substrates. The metal material of new claim 27 provides this assurance.

Additionally, it is important that as discussed herein above, that the prong members 16, 17 are structured such that they can cleanly and easily penetrate into and remain in the first substrate. This is accomplished by the planar width of the prong members 16, 17 being

substantially less than the planar width of the flat portion and the single step portion 14 as recited in new claim 24; by the prong members 16, 17 consisting of one flat plane as recited in new claim 24; by the prong members 16, 17 having pointed ends and at least one barb along their length as recited in new claim 25; and by the clip including prong members 16, 17 being of a metal material as recited in new claim 27 since metal material may provide more rigidity compared to other types of material, i.e., flexible polymer or plastic materials.

Claim Rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a)

Claims 1, 4, 7 and 21-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,441,680 to Rivkin et al. (the Rivkin reference). Claims 5 and 6 stand rejected under 35 U.S.C. §103(a) for obviousness over the Rivkin reference.

With regard to the first rejection, the Examiner's position is that the Rivkin reference shows a clip comprising a body having a first side and a second side; a flat portion 10 between the first side and the second side; a step portion 12 located on the flat portion, with portions of the flat portion located on opposite sides of the step portion; a first prong member projecting outwardly from the first side of the body; and a second prong member projecting outwardly from the second side of the body, with the first and second prong members bent transverse to the body in a first direction and the step portion is transverse to the body in the second direction. The body, the flat portion, the step portion, the first prong member and the second prong member are formed from a one piece blank member. The step portion has an open faced recess projecting outwardly in the first direction. The first prong member and the second prong member have pointed ends and at least one barb along their length. The clip is polymeric material, and the material thickness for the flat portion, the step portion and the prong members is uniform. The planar width of the prong members is less than the planar width of the flat portion and the step portion. Portions of the flat portion located on opposite sides of the step portion have a smooth and continuous undersurface extending between the step portion and the prong members. In view of these characteristics, the Examiner states that the structure of the anchor of the Rivkin reference is able to meet the intended use as claimed.

Claim 1 has been further amended to include patentable distinctions not found in the Rivkin reference. First, the Rivkin reference discloses an anchor for stabilizing and securing hangers in a perforated wall board. An elongated member of this anchor has a central

curvilinear portion 12 for embracing a perforated board hanger 24, an elongated offset combined curvilinear and straight off-set portions 16 and 17 on each side of the central curvilinear portion 12, and an end portion 14. As shown in Figure 6, the central curvilinear portion 12 holds the hanger 24 and the curvilinear and straight off-set portions 16 and 17 on each side of the central curvilinear portion 12 hold the hanger 24 when the end portions as shown in Figure 4 are forced to a position substantially 90 degrees from its normal positions of Figures 1 and 2. It is apparent that the anchor of the Rivkin reference of Figure 6 contains at least three step portions; whereas, the clip of claim 1 as amended consists of only one single step portion 14, which as explained with reference to claim 24 generally is used to space one substrate from the other substrate.

Second, the anchor of the Rivkin reference has a planar width as illustrated in Figure 2 as being uniform along the entire length of the elongated member 14 forming the anchor. In the claimed invention of claim 1 as amended, the planar width of the first prong member substantially along its length and the planar width of the second prong member substantially along its length are substantially less than the planar width of the flat portion and the single step portion. This distinction is quite apparent in Figure 2A of the instant patent application.

Third, the thickness of the components of the anchor of the Rivkin reference appears not to be uniform in that the ends 14 have quadrants which contain the barbs 18 and pointed ends 22. In the claimed invention of claim 1, the components, i.e., the flat portion, the single step portion 14, the first prong member 16 and the second prong member 17, have a uniform thickness.

Fourth, as stated in the preceding paragraph, the ends 14 of the Rivkin reference have quadrants which contain the barbs 18 and the pointed ends 22; whereas in amended claim 1, the first prong member 16 and the second prong member 17 consist of one flat plane from which the barbs and pointed end extend.

As discussed hereinabove, these structural features of the prong members 16, 17 as now recited in claim 1 are important patentable distinctions which enable the clip of the invention to be easily pierced or penetrated into a substrate and then retained in the substrate.

A further point which Applicant wishes to make is that the Rivkin reference pertains to an anchor for stabilizing and securing one or more hangers 24 to a perforated wall board by inserting the ends 14 into apertures in the wall board. The elongated member has sections as discussed hereinabove for embracing a portion of the shank of hangers 24. In the

embodiment of Figure 6, three hangers 24 are supported by the anchor and in the embodiment of Figure 5 one hanger 24 is supported by the anchor.

Applicant considers this Rivkin reference to be non-analogous art and that it would take a far stretch of the imagination to equate this anchor with the clip of the claimed invention since the anchor of the Rivkin reference and the clip of the claimed invention would not function in a similar manner to produce a similar result. For example, the anchor of the Rivkin reference has ends 14 which contain quadrants with barbs 18. This structure is necessary so that the ends 14 can be pushed into the apertures of the wall board and then locked into the apertures of the wall board so that the hangers 24, if released from the wall board, do not pull the anchor out of the wall board. In the embodiment of Figure 6, the anchor spans across the wall board and the two ends 14 are inserted into a different aperture in the wall board. In the embodiment of Figure 5, the elongated member is bent around to embrace the shank of hanger 24 and both ends 14A and 14B are inserted into the same aperture.

The prong members 16, 17 of the clip of the claimed invention are structured such that they can be easily inserted into a substrate so as to space one substrate away from another substrate. There is no concern that the weight of any components in the system will pull the clip out of the substrate. It is not necessary for the substrate to have apertures for receiving the clip 10. If the clip 10 of the claimed invention is used in the environment of the Rivkin reference, it can be appreciated that the clip 10 will very easily release out of the aperture or apertures of the wall board. Therefore, the clip of the claimed invention cannot function in a manner similar to the embodiments of Figures 5 and 6 of the Rivkin reference.

Additional support for this position appears in column 3, line 49 to column 4, line 2 of the Rivkin reference. This disclosure describes the different designs for ends 14, 29 depending on the thickness of the wall board. The ends 29 of Figure 6 accommodate a specific and consistent thickness of the perforated board 28, and the anchor with ends 14 shown in Figures 1-5 accommodates any thickness of perforated board 28. In the claimed invention, the location of the barbs along the length of prongs 16, 17 is not critical for the clip 10 to function properly for its intended use, i.e., with sound absorbing media used with roof decks (claim 23) or to space apart two substrates (new claim 24).

Thus, it is apparent that the clip of the claimed invention cannot function similarly to the anchor of the Rivkin reference for securing hangers to a wall board. The

same analogy holds true for the anchor of the Rivkin reference. That is, the structure of the anchor of the Rivkin reference is not able to meet the intended use of the clip 10 of the claimed invention.

As stated hereinabove, it is important that the prongs 16, 17 of the invention have the structure as now claimed in claim 1 so that the clip 10 can easily pierce through a substrate such as a sound absorbing media 2 which generally is fiberglass or the like as disclosed in paragraph [0027] of the instant application. If one attempts to insert the anchor of the Rivkin reference into this fiberglass substrate, first since the ends 14 and 29 of the anchor of the Rivkin reference contain quadrants with barbs and a pointed end and not a one plane surface as the claimed invention, one will encounter a great amount of resistance since the quadrant ends 14, 29 of the anchor have a greater surface area for penetration. Second, if one does manage to penetrate the anchor into the fiberglass substrate, quite an amount of fiberglass material will become dislodged from the substrate in view of the greater surface area of penetration of the quadrant ends 14, 29 of the anchor of the Rivkin reference. This dislodging of the fiberglass material may result in destruction of the fiberglass substrate. Compare this to the prongs 16, 17 of the clip 10 of the invention, which are structured to provide a clean knife-like penetration into the substrate.

For the reasons hereinabove, Applicant submits that the limitations of claim 1 as amended are not disclosed, taught or suggested in the Rivkin reference, and therefore claim 1 is believed to be patentable over the Rivkin reference. Also, none of the prior art of record overcomes the deficiencies of the Rivkin reference. Therefore, claim 1 is also not obvious in view of the prior art of record.

Claim 21 has been cancelled. Claims 4-7 and 22-23 depend directly or indirectly from claim 1 and add further limitations to claim 1. Since these claims depend from a claim believed to be in condition for allowance, these claims are also believed to be in condition for allowance.

Reconsideration of the rejections of claims 1, 4-7 and 22-23 and allowance thereof are respectfully requested.

#### New Claims 24-27

Claims 24-27, addressed to a clip for spacing two substrates apart, are patentable in view of the Rivkin reference for the same reasons propounded above for the patentability of

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claims 1, 4-7 and 22-23. That is, the above arguments for the patentability of claims 1, 4-7 and 22-23 apply here with equal force.

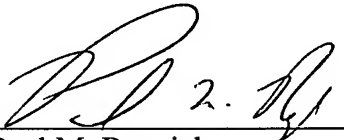
New claim 28 which is based on claim 1 but which is more limiting since it recites "consisting of" instead of "comprising" in the preamble, is also patentable for the same reasons that claim 1 is believed to be patentable. New claim 29 directly depends on claim 28 and adds further limitations to claim 28. This claim 28 is also believed to be patentable.

### Conclusion

In view of the above amendments and remarks, reconsideration of the rejections and allowance of claims 1, 4-7 and 22-23 are respectfully requested. Also, allowance of claims 24- 29 is respectfully requested.

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